

## REMARKS

New claims 26-30 are added. The new claims are supported by exemplary embodiments disclosed in the originally-filed application at, for example, pgs. 5-6. Reconsideration of the application in view of the amendments and the remarks to follow is requested.

The drawings are objected to wherein the Examiner alleges newly added Figs. 2a and 2b are new matter. The drawings are amended to cancel Fig. 2a. Applicant traverses the objection to Fig. 2b which is explained more thoroughly below. Moreover, the drawings are amended to again include the originally-filed Fig. 2. Since Fig. 2 was filed with the originally-filed application, no new matter is added.

The amendment filed February 23, 2004 is objected to under 35 U.S.C. §132 for allegedly introducing new matter into the disclosure, particularly referring to the disclosure addressing previously added Figs. 2a and 2b. The disclosure directed to Fig. 2a is cancelled. Applicant traverses the objection to Fig. 2b which is explained more thoroughly below, and therefore, the disclosure to Fig. 2b remains.

Claims 1-4 and 22-25 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In the context of enablement commensurate in scope with the claims, the Examiner is respectfully reminded that the Federal Circuit has repeatedly held that “the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation’” *In re Wright*, 999 F.2d 1557, 1561,

27 USPQ2d 1510, 1513 (Fed. Cir. 1993); MPEP §2164.08 (8<sup>th</sup> Ed.). Nevertheless, not everything necessary to practice the invention need be disclosed. MPEP §2164.08 (8<sup>th</sup> Ed.). In fact, what is well-known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); MPEP §2164.08 (8<sup>th</sup> Ed.). All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. MPEP §2164.08 (8<sup>th</sup> Ed.). Further the scope of enablement must only bear a “reasonable correlation” to the scope of the claims. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970); MPEP §2164.08 (8<sup>th</sup> Ed.).

In response to the enablement rejection, Applicant submits with this response a Declaration by Ulrich Bingel, a person skilled in the art, pursuant to 37 C.F.R. §1.132. The Examiner first refers to the original-filed Fig. 2 and disclosure at pg. 6, Ins. 30-34 and states it would appear (presumably referring to Fig. 2) that the positioning of the plurality of optical elements (mirrors) on the basic body would prevent an intermediate layer from being formed between the basic body and the individual optical elements during the galvanoplastic joining technique (pg. 3 of paper no. 20040321). Please note, respectfully, the intermediate layer 10 is not formed in a stacked configuration with the basic body 8 and optical elements 9. That is, the optical elements 9 are on and “touch” the basic body 8 as clearly stated by the originally-filed application and explained by Ulrich Bingel (paras. (b)-(g) of the Declaration). Ulrich Bingel makes it clear that one skilled in the art would not interpret Fig. 2 and the disclosure at pg. 6, Ins. 30-34 in the manner presented by the Examiner, and

that one skilled in the art understands that intermediate layer 10 is on portions of basic body 8 between respective optical elements 9 (paras. (b)-(g) of the Declaration).

Please further note, Fig. 2 clearly illustrates basic body 8 and intermediate layer 10 as being hatched, that is, with **hatch lines** while optical elements 9 are **not** hatched. That is, the sectional view of Fig. 2 has the hatched portions of basic body 8 and intermediate layer 10 in the same plane of the page, while optical elements 9, since not being hatched, are illustrated **behind** the plane of the page. Accordingly, the originally-filed Fig. 2 clearly illustrates that basic body 8, intermediate layer 10 and optical elements 9 are not arranged in a staked orientation, but are oriented, from the Fig. 2 view, with the intermediate layer 10 in front of the illustrated optical element 9. As Ulrich Bingel explains, one skilled in the art understands the arrangement from viewing Fig. 2. This arrangement is also shown in Fig. 2b as a side view of Fig. 2.

Regarding Fig. 2b, Applicant submits such illustration is inherent from the originally-filed disclosure, including Fig. 2. Further evidence of the inherency of Fig. 2b with respect to Fig. 2 is demonstrated by the Declaration at, for example, para. (g). Applicant submits since Fig. 2b is inherent from the originally-filed application, the objection against Fig. 2b and the objection to portions of the specification directed to Fig. 2b are inappropriate and should be withdrawn.

Moreover, the Examiner states it would appear (again presumably referring to Fig. 2) that the positioning of the plurality of optical elements (mirrors) on the

basic body would result in substantially covering all exterior surfaces of the optical elements during the galvanoplastic joining technique (pg. 3 of paper no. 20040321). As Ulrich Bingel explains, one skilled in the art knows how to avoid inadvertently covering optical elements by galvanic deposits (Declaration at para. (h)). Moreover, Applicant submits that it is well known and understood how to remove material from over a substrate, such as galvanic deposits over optical elements. This is further evidence that the claims are enabled.

In conclusion, Ulrich Bingel's declaration demonstrates that the originally-filed specification teaches those skilled in the art how to make and use the full scope of the claimed invention without "undue experimentation", pursuant to the above authority. Therefore, the §112, first paragraph rejection against claims 1-4 and 22-25 is inappropriate and should be withdrawn.

No other rejections are presented against claims 1-4 and 22-25, and therefore, the claims are allowable.

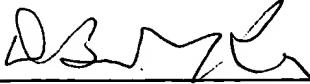
Moreover, the objection to Fig. 2b is inappropriate since such figure is inherent from the originally-filed disclosure, including Fig. 2. Accordingly, the objection against Fig. 2b and the objection to portions of the specification directed to Fig. 2b are inappropriate and should be withdrawn.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 8-23-04

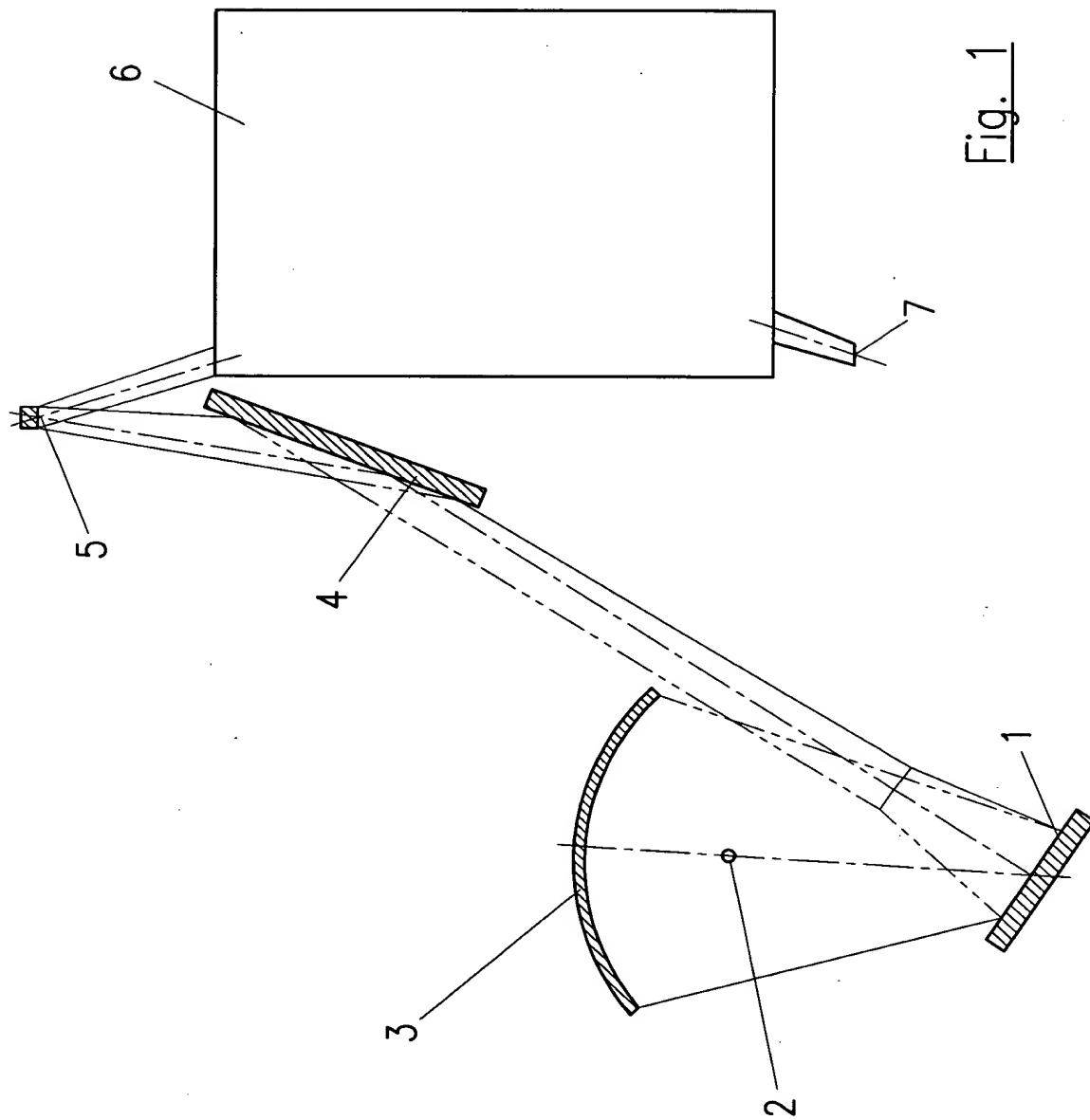
By:

  
D. Brent Kenady  
Reg. No. 40,045



ANNOTATED SHEET SHOWING CHANGES

1/X3

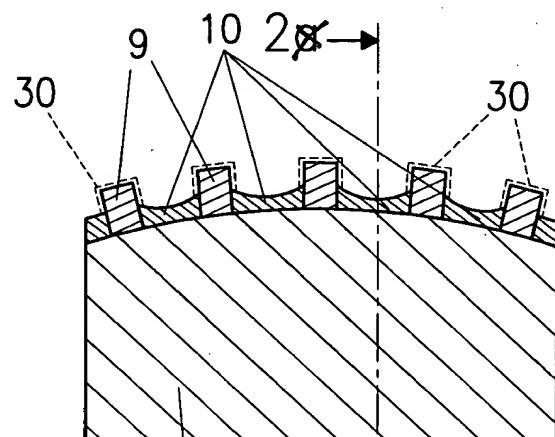
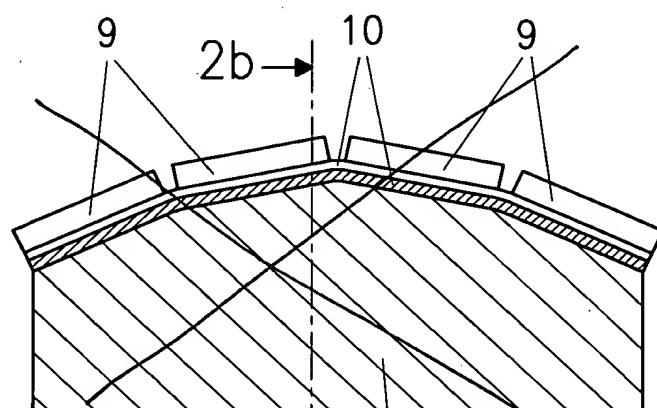


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ANNOTATED SHEET SHOWING CHANGES

ADDED FIG. 2

2/X3



2b →

Fig. 2a

2x →

Fig. 2b

3/3 SEPARATE SHEET

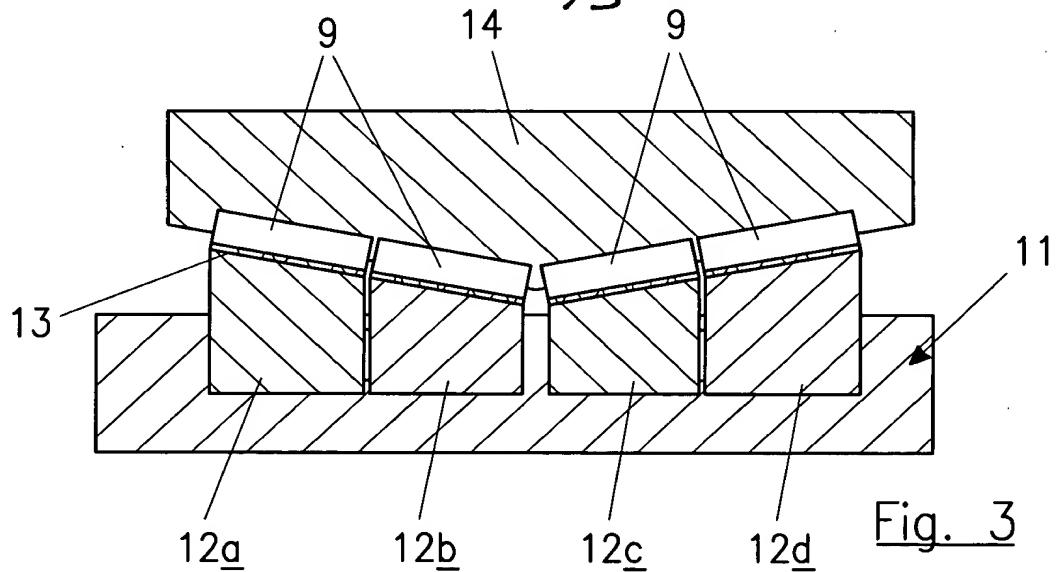


Fig. 3

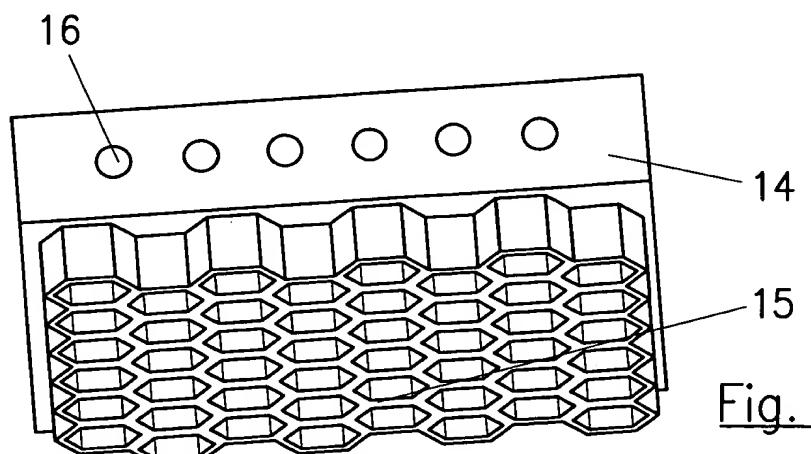


Fig. 4